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SEP 12 2008

OFFICE OF PETITIONS

In re Application of :
Miller et al. :
Application Number: 10/565382 : ON PETITION
Filing Date: 01/20/2006 :
Attorney Docket Number: 60,469- :
253;OT-5210 LAB :

This is a decision in reference to the "REQUEST TO WITHDRAW NOTICE OF ABANDONMENT," filed on July 7, 2008, which is treated as a petition under 37 CFR 1.181.

The petition is **DISMISSED**.

This application became abandoned on February 10, 2008, for failure to timely submit an appeal brief in response to the Notice of Patent Decision from Pre-Appeal Brief Review mailed on January 9, 2008, which set a one (1) month period for reply. On February 11, 2008, one page entitled "AFTER FINAL AMENDMENT," was received. On June 27, 2008, Notice of Abandonment was mailed.

Petitioner asserts that an after final amendment was filed on February 11, 2008, and that the examiner had agreed, during a telephone interview held after the mailing of the Notice of Patent Decision from Pre-Appeal Brief Review mailed on January 9, 2008, that the case would be allowed if claims were amended as they are presented in the after final amendment.

Petitioners further assert that a complete amendment after final rejection was filed by facsimile on February 11, 2008. In support, petitioners have provided a copy of the USPTO Auto-Reply Facsimile Transmission cover sheet, showing the first page of the after final amendment, and stating that nine (9) pages (including the cover page) were received on February 11, 2008. A copy of the eight (8) page amendment has also been provided.

37 CFR 1.8(b) states:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The petition lacks item (3). Petitioner has not provided a statement by the person who signed the Certificate of Facsimile Transmission which attests on a personal knowledge basis to the previous timely mailing or transmission. Petitioners should provide a statement by Theresa M. Palmateer, the person who signed the Certificate of Facsimile Transmission dated February 11, 2008.

Additionally, assuming, *arguendo*, petitioner's response is considered timely filed:

37 CFR 1.135 states, in pertinent part.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the

condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

In this regard, the Notice of Panel Decision from Pre-Appeal Brief Review mailed on January 9, 2008, stated, *inter alia*, that the application remains under appeal, and that the time for filing an appeal brief runs from one (1) month from the mailing date of this decision.

37 CFR 41.37(a)(1) states that appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31. 37 CFR 41.37(b) states that on failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

MPEP 1205.01 states, in pertinent part:

If the time for filing a brief has passed and the application has consequently become abandoned, the applicant may petition to revive the application under 37 CFR 1.137, as in other cases of abandonment. See MPEP § 711.03(c). ... In addition to the petition and petition fee, appellant must file:

(A) A request for continued examination (RCE) under 37 CFR 1.114 accompanied by a submission (i.e., a reply under 37 CFR 1.111) and the fee as set forth in 37 CFR 1.17(e) if the application is a utility or plant application filed on or after June 8, 1995, or a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application); or

(B) An appeal brief and the appeal brief fee to reinstate the appeal. A proper brief and the required fee must be filed before the petition will be considered on its merits.

37 CFR 1.2 states that the action of the U.S. Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. Moreover 37 CFR 1.116 is manifest that

the admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135.

The showing of record is that petitioners did not timely file a proper reply to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on January 9, 2008. To this end, an amendment after final rejection is not a proper response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on January 9, 2008. As such, the application became abandoned as a matter of law for failure to timely and properly reply to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on January 9, 2008.

Abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action.¹ The rule clearly indicates that the mere filing of an amendment does not save the application from abandonment. Only the filing of an Appeal Brief, Request for Continued Examination and submission under 37 CFR 1.114, or continuing application guarantees the pendency of the application, not filing an amendment after final rejection. Thus, the application became abandoned due to petitioner's failure to file an Appeal Brief, RCE and submission, or continuing application prior to the period for reply to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on January 9, 2008, and not because of any error on the part of the Office.

Further, the official written record contains no indication that the examiner had agreed to accept an amendment after final rejection in lieu of the reply required by the Notice of Panel Decision from Pre-Appeal Brief Review mailed on January 9, 2008.

To this end, 37 CFR 1.2 states that the action of the U.S. Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

¹ MPEP 711.03(c). See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-300 (CCPA 1964); Krahn v. Commissionerr, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

In summary, to the extent that petitioner's counsel believed that the examiner had agreed that an Appeal Brief, RCE and submission, or continuing application were not required, and that an amendment after final rejection was a proper submission, there is no showing in the written record to support that allegation. As MPEP 711.03(c) states, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicants' reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicants of any deficiency in sufficient time to permit the applicant to take corrective action.²

The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.³ Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.⁴

As such, the showing of record is that the abandonment resulted from the failure of petitioners to file a timely and proper response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on January 9, 2008, rather than an error on the part of the USPTO.

As such the application is properly held abandoned.

The petition is **DISMISSED**.

Petitioner may wish to consider filing a petition to revive under 37 C.F.R. 1.137(b).

Any request for reconsideration must be filed within **TWO (2) MONTHS** of the date of this decision.

² See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

³ Link v. Wabash, 370 U.S. 626, 633-34 (1962).

⁴ Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N. D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

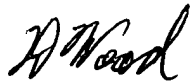
Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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